

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 13

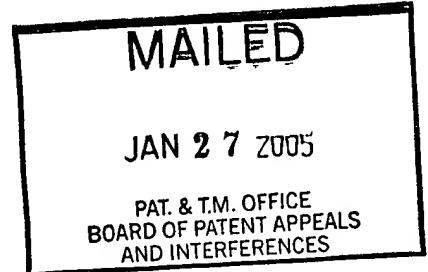
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSEL DALE COLE

Appeal No. 2005-0311
Application No. 09/656,013

ON BRIEF



Before COHEN, FRANKFORT, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 7 through 10, all of the claims remaining in the application. Claims 1 through 6 have been canceled.

As noted on page 1 of the specification, appellant's invention generally relates to a holder for a photograph or the like that uses a magnet to attract and retain the holder to a metallic surface. More particularly, appellant's invention addresses a corner pocket form of holder for a photograph, calendar or the like wherein only a corner portion of the object

to be supported and held is received in a triangular shaped pocket including a first layer therein having a non-slip surface to engage and bear against a surface of the object to be held and having a layer of magnetic material used to secure the holder to a metallic surface. Figure 1 of the application drawings shows an exploded view of one form of appellant's corner pocket holder and Figure 2 shows an alternative corner pocket holder.¹ Independent claim 7 appears to be directed to the embodiment of Figure 2, while independent claim 9 appears to be directed to the embodiment of Figure 1. Independent claims 7 and 9 are representative of the subject matter on appeal, and a copy of those claims can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the claims before us on appeal are:

Engel	2,068,909	Jan. 26, 1937
Good	4,785,562	Nov. 22, 1988

¹It appears to us that Figure 1 of appellant's drawings incorrectly depicts the invention, because magnetic material layer (5) therein is an outer rear layer of the corner pocket holder (1) and should be shown as such. Thus, the broken line representation of the top portion of layer (5) seen in Figure 1 should be shown in solid lines, while the portion of layer (3) underlying layer (5) should be shown in broken lines.

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Claims 7 through 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Engel in view of Good.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we refer to the final rejection (Paper No. 7, mailed September 11, 2002) and the examiner's answer (Paper No. 11, mailed April 9, 2003) for an exposition of the examiner's position, and to appellant's brief (Paper No. 10, filed January 23, 2003) for the arguments thereagainst.

OPINION

Having carefully reviewed the examiner's obviousness rejection in light of the record before us, we have made the determination that this rejection will not be sustained. Our reasoning follows.

²Notwithstanding the examiner's silence on the issue, it appears from the record that the amendment of claims 7 through 10 in Paper No. 9, filed subsequent to the final rejection and entered by the examiner, has overcome the rejection of claims 7 through 10 under 35 U.S.C. § 112, second paragraph, set forth on pages 2-4 of the final rejection. In that regard, we note that rejections not repeated in the examiner's answer are considered to have been withdrawn by the examiner. See, for example, Ex parte Emm, 118 USPQ 180 (Bd. App. 1957).

In making the rejection of claims 7 through 10 under 35 U.S.C. § 103(a), the examiner is of the opinion that Engel discloses (in Figures 5 and 6) a holder for an object such as a photograph, picture, card, or the like wherein the holder comprises three layers, i.e., a first layer (30) having a non-slip gummed surface to engage and bear against a surface of the object (5) to be held, a second layer (10) providing a fastening means that may be applied directly against and held to a supporting surface (6), and a third layer (20) consisting of at least one layer of a transparent material configured to define a corner receiving pocket between the third layer and the first layer of the holder. The only difference identified by the examiner between the holder of Engel and that claimed by appellant is that the second layer (10) of Engel constitutes a triangular sheet of paper gummed on both sides instead of having, or being formed of, magnetic material as required in the claims on appeal.

To account for the above-noted difference, the examiner looks to the teachings of Good, contending that this patent teaches using magnets (80) for securing a picture frame (Fig. 2) and a picture (50), or corner pieces (Figs. 4a-4d) and a drawing

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(52), to a metallic supporting surface (60). Based on the collective teachings of Engel and Good, the examiner has concluded that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention "to modify Engel with magnets as a securing means in order to allow for quicker and easier attachment and detachment, and avoiding the residue commonly associated with adhesive" (final rejection, pages 4-5).

Appellant argues in the brief (e.g., page 8), that there is no suggestion in the prior art applied by the examiner that the magnets of Good which hold frame members to a supporting surface can be used in a corner pocket holder for the corner edge of an object to be held in the particular manner disclosed in Engel, and that neither Engel nor Good suggest, teach, or otherwise motivate one of ordinary skill in the art to change the adhesive of Engel's layer (10) to a magnetic material.

After careful consideration of the object display holders disclosed in Engel and Good, and the teachings fairly derived therefrom, we agree with appellant. More specifically, we note that each of the advantages relied upon by the examiner on page 6

of the answer to provide motivation or suggestion to modify Engel in view of Good is achieved by the frame holders of Good alone and, in our view, would thus have motivated one of ordinary skill in the art at the time of appellant's invention to merely use magnetic corner holders like those seen in Figure 1 and Figures 4a-4d of Good when seeking to secure an object such as a photograph, picture, drawing or the like to a metallic supporting surface, instead of suggesting replacement of the adhesive on a portion of a corner pocket holder of the type seen in Engel. Like appellant, we find nothing in either Engel or Good regarding a teaching or suggestion which would have motivated one of ordinary skill in the art at the time of appellant's invention to selectively combine the features of the two different forms of holders shown in Engel and Good in the particular manner posited by the examiner.

In that regard, we note that the mere fact that the prior art could be modified in the manner urged by the examiner would not have made such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed.

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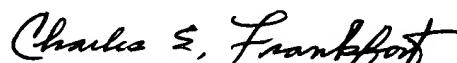
Cir. 1992). In this case, it is our opinion that the prior art does not contain such a suggestion and that the examiner has impermissibly drawn from appellant's own teaching and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

Since we have determined that the teachings and suggestions which would have been fairly derived from the references applied by the examiner would not have made the subject matter as a whole of independent claims 7 and 9 on appeal obvious to one of ordinary skill in the art at the time appellant's invention was made, we must refuse to sustain the examiner's rejection of those claims and the claims which depend therefrom under 35 U.S.C. § 103(a). Thus, the examiner's rejection of claims 7 through 10 under 35 U.S.C. § 103(a) based on Engel and Good will not be sustained.

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In light of the foregoing, the decision of the examiner is reversed.

REVERSED


IRWIN CHARLES COHEN)
Administrative Patent Judge)
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CHARLES E. FRANKFORT) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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JENNIFER D. BAHR)
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